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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/475,359

12/30/1999

HARRI HELLSTEN

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12/23/2003

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EXAMINER

TRIEU, LAURENT L

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/475,359

Applicant(s)

HELLSTEN ET AL.

Examiner

Laurent Trieu

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-16 have been examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 6 and 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 16, the term comprising is used, but no new element is added. It is unclear if this is meant to add an additional element, or to further describe the element already disclosed. The claim is read as saying "The system of claim 13 wherein the application source is located remotely from the manufacturer of the application."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose, European Patent number EP 0778,512 A2.

With regards to claims 1, 5, 8, 10, 13 and 15, Rose discloses a method for downloading applications to a user station, "Upon selecting an application (or the Application Builder) for downloading" (column 8, lines 30-34) by sending an order for an application including a user identifier, "The information from the user..." (column 9, lines 5-9) which identifies the user to the source "thereby providing the owners with reliable information about the parties who have requested trial use of those programs" (column 9, lines 9-11), the source then configures the application to include as a variable the value of the user's identifier, "... contains user identification information..." (column 9, lines 21-25), and downloads the application directly to the user, "...transmits the Transmission Format version of the requested Application Program to the client computer" (column 9, lines 15-21) where it is matched with the identifier on the client computer when executed, "Client ID matches Licensee ID..." (column 12, lines 36-42).

With regards to claims 2 and 14, Rose discloses comparing the identifier to a library of identifications, "... then comparing the Licensee ID 184 in the file with a client ID (or a list of Client IDs)..." (column 12, lines 7-12).

With regards to claim 3, Rose discloses that the application "may either be created and stored as an actual file on the server..." (column 5, lines 53-57) and informs the user that it is ready (column 8, lines 34-42).

With regards to claim 4, Rose discloses that the time and date can be included in the identification information, "... optionally includes a header that specifies trial license expiration conditions such as a trial license expiration date..." (column 11, lines 39-45).

With regards to claim 9, 12 and 16, as best understood, Rose discloses that the server is not necessarily the manufacturer, but is a distributor, "...for managing the distribution of licensed files..." (column 2, lines 17-20), which contains a template, "... a trial licensing application program 134 for handling the licensing of Application Programs to end users associated with client computers 102, a copy of the aforementioned Application Builder 136 for transmission and licensing to end users, a pair of public and private encryption keys 137 for the server, and copies of the trial versions of various Application Programs 138, 130, 142 for transmission and licensing to end users." (column 4, lines 4-16).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Pashley et al., US Patent number 5,978,833.

With regards to claim 6, Rose discloses the method of claim 1, as outlined above, but does not mention using the identifier for the purpose of billing. Pashley discloses a software distribution system, "to provide a means for accessing information on the internet" (column 1, lines 44-45) where the identification information gathered is used additionally for billing purposes, "the identification number is used for billing purposes" (column 7, lines 16-34). It would have been obvious to one of ordinary skill in the art to use the identifier in Rose's method for billing purposes, as taught by Pashley. The motivation would have been for ease of billing purposes - "to charge the user ... each time a search is executed." (Pashley - Column 7, lines 32-33)

With regards to claim 7, Rose discloses the method of claim 1, as outlined above, and teaches using other types of communication systems, "While most client computers are desktop computers such as Sun workstations, IBM compatible computers and Macintosh computers, virtually any type of computers can be a client

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computer" (Rose - column 3, lines 27-31), but does not specifically mention wireless networks. Pashley discloses that wireless networks are available for file transfers, "The wireless modem communication..." (Pashley - column 1, line 37). It would have been obvious to one of ordinary skill in the art to use Rose's method in a wireless network. The motivation would have been to use wireless as an alternate means depending on cost / performance choices (Pashley - Column 5, lines 38-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurent Trieu whose telephone number is 703-305-0712. The examiner can normally be reached on Monday - Friday, 7AM - 4PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100